

REMARKS

Claims 41-110, 114-125, 128-135, and 138-145 have previously been canceled, without prejudice. Original claims 1-40, 111-113, 126, 127, 136, 137, and 146 remain in the application.

Claims 14 and 15 are rejected for vagueness for failing to “further limit the demographic data claimed in claim 10.” The applicants respectfully submit that dependency from a claim is permitted not only for the purpose of further limiting a limitation added by the claim, but may also be used for further limiting a combination of elements of the claim. In this latter regard, claim 10 adds “user demographic data” to client information recited in claim 9, while claims 14 and 15 further limit the combination of elements that make up the “client information with user demographic data” claimed in claim 10 by adding to it “features of the software used by the user” (claim 14) and “user-selected settings” (claim 15). Accordingly, the applicants respectfully request withdrawal of this rejection.

Claims 1-40, 111-113, 126, 127, 136, 137, and 146 are provisionally rejected for obviousness-type double patenting over US Patent Application No. 09/668,553. In view of the fact that prosecution is still ongoing in that application, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in both applications.

Claims 1-6, 9, 12, and 13 are rejected for obviousness over US Patent No. 5,848,397 (“Marsh”). (In fact, it would appear that all claims remaining in this application have been rejected for obviousness over Marsh, and the following remarks are predicated on that assumption). That rejection is respectfully traversed for the following reasons.

Claim 1, which is representative of the rejected claims, is directed to software for use on a client device that is configured for communications with at least one remote source of advertisements via a communications network. The software includes an advertisement download function that downloads advertisements from the at least one remote source, during one or more advertisement download sessions, an advertisement storage function that stores the downloaded advertisements on a storage medium associated with the client device, and an advertisement display function that effects

display of at least selected ones of the stored advertisements on a display associated with the client device. Claim 1 (and all of the rejected claims) further comprehends:

"an audit function that compiles ad-related statistical data relating to the downloaded advertisements, wherein the ad-related statistical data includes display event-related data regarding advertisements that were displayed during a prescribed audit interval;

an audit data transmit function that transmits the ad-related statistical data to a prescribed server system,

wherein:

the audit data transmit function generates a send audit data display window that requests the user's permission to transmit the ad-related statistical data to the prescribed server system; and

the audit data transmit function transmits the ad-related statistical data only in response to a user's grant of permission to do so."

The prior art cited in the Office Action in support of this rejection is Marsh, and the assertion is that, since Marsh teaches sending statistical data to a server, Montague (US Patent No. 6,298,332), in teaching the user-authorized transmission of vendor-supplied information, would have made obvious to a person of ordinary skill in the art at the time of the applicants' invention the inclusion "in the system of Marsh the teaching of Montague of sending the data only in response to a user's grant of permission to do so because such a modification would allow the users to have control of the data that is transmitted."

As implicitly conceded in the Office Action, at the time the invention was made, the prior art did not teach a client device software with advertisement download, storage, and display functions including an audit data transmit function that transmits "ad-related statistical data to a prescribed server system" by generating "a send audit data display window that requests the user's permission to transmit the ad-related statistical data to the prescribed server system" and then by transmitting the ad-related statistical data "only in response to a user's grant of permission to do so". See MPEP 2141.01 III. In fact, the only way which such an invention could be appreciated during examination is with reference to the applicants' specification. However, such hindsight reasoning is expressly forbidden. See *In re Dembiczak*, 50 USPQ2d at 1617, (Fed. Cir. 1999).

The only support given for the proposed modification of Marsh by addition of the audit display window that requests the user's permission and then sending only when

the user gives permission is the teaching of Montague that a user may selectively authorize the sending of vendor data obtained from a CDE tag to a vendor.

In contrast, two problems are addressed by the invention of the rejected claims. First is the problem of fraudulently-placed ads, which can be detected by statistical analysis. See the specification at page 65, line 29 through page 67, line 6. As the specification makes clear, the data necessary to the analysis is ad-related statistical data such as that illustrated in the tables on pages 67 and 68 of the specification, which must be gathered from users. But this gives rise to the problem of protecting the user's privacy in the collection of such data. See the specification at page 68, line 2 through page 69, line 12:

"One of the issues which the software provider must be very cognizant of is the protection of the user's privacy, i.e., the user generally does not want to receive ads based on information that the user unknowingly submitted to the software provider. There is an extremely vocal and paranoid subset of the user community, who object to practically all forms of information gathering, even the most benign." Specification, page 68, lines 2-6.

The solution is to explicitly ask for the user's permission to send the data, and then to send the data only when the user grants that permission. This solution is implemented in the functions that are explicitly recited in claim 1, and that limit all of the rejected claims.

Marsh does not teach or suggest any action at all that requests permission to send ad statistics and then sends ad statistics only when permission is granted. The sending of ad statistics solves problems that are different than the problems solved by the invention of the rejected claims. In this regard, Marsh's message presentation apparatus logs ad statistics and reports them back to a server system to schedule ad downloading and "for use in billing vendors." Marsh, column 4, lines 38-40.

Further, ad statistics are not required by the invention of the rejected claims for billing purposes as in Marsh. Instead, ad downloading initiates the billing event. That is to say, the primary purpose of the invention "is to distribute paid advertisements". See the definition of "advertisement" in the specification of this application at page 12. The ad-related statistical data is utilized for proving that paid-for ads are actually viewed.

Accordingly, there was no suggestion at the time the invention was made to modify Marsh by adding an audit-data transmission function that requests permission to send ad-related statistical data and then sends such data only when permission is granted.

Moreover, if statistical data were sent only with a user's permission in Marsh's message scheduling apparatus, many users would refuse permission. Remember that Marsh depends on ad statistics for scheduling and billing. In those cases where users refused permission to send the ad statistics, ad downloading could not be scheduled for such users. Further, fewer reports would result in vendors being under-billed. Accordingly, there is no reasonable expectation of success in modifying Marsh as proposed in the Office Action.

Further, even if Marsh were modified to incorporate Montague's authorization action, the result would omit "a send audit data display window that requests the user's permission to transmit the ad-related statistical data to the prescribed server system". This element is described in the specification and illustrated in FIG. 18A of this application. No such element is taught or suggested in Marsh. Montague only describes the ability of a user to "selectively authorize transmission of various data 174, 176 to and from a vendor base". Montague, column 9, lines 22, 23. However, Montague specifies no means or mode for giving such authorization. Accordingly, no *prima facie* case of obviousness has been established. See MPEP 2143 *et seq.*

With respect to claim 7, the software of claim 1 is further limited by a server system "auditing manager function" that generates a "send audit data request in accordance with a client auditing policy under which send audit data requests are transmitted to a statistical sampling of a population of client devices, at prescribed times". As set forth in claim 6, the audit data request activates the audit data transmit function at a user. The contention in the Office Action is that "Marsh teaches a client policy...". See the Office Action at page 5, first paragraph. In fact, Marsh at column 3, lines 12-27 describes an advertisement distribution scheduler that decides which ads are to be sent, and to whom, based on user profile information. At column 7, lines 7-22, Marsh describes the processing of a client system in displaying advertising. Neither passage of Marsh describes or suggests any manager in a server that activates an audit data transmit function, or that generates audit requests "in accordance with a client auditing policy". In fact, Marsh does not describe or suggest a "client auditing policy." Accordingly, the applicants respectfully request citation of a reference or entry of an affidavit to support this contention. See MPEP 2144.03.

With respect to claim 8, the software of claim 1 is further limited by a server system "auditing manager function" that generates a "send audit data request in accordance with a client auditing policy under which send audit data requests are

transmitted to random ones of a population of client devices, at prescribed times". Official Notice is taken that "it is old and well known to perform a function at random in order to protect the data has been transmitted." See the Office Action at page 5, second paragraph. Perhaps this is so in the computer arts generally; however, claim 8 is not directed to general data problems. Instead, the claim is directed to further characterization of an auditing manager function in eliciting activation of an audit data transmit function. It is respectfully submitted that this limitation of the audit data transmit function is not and cannot be of such notorious character as to merit Official Notice. Accordingly, the applicants respectfully request citation of a reference or entry of an affidavit to support this statement. See MPEP 2144.03.

Claims 10, 11, 14, 15, 17, and 29 are dependent from claim 1 which is patentably distinguishable from Marsh for reasons given above.

With respect to claims 21, 22, 27, 28, 30, 31, 33, 34, 36, and 37, an advertisement distribution server system is managed by either a producer or a distributor of the software being claimed. The contentions in the Office Action at page 5, paragraphs 4 and 5 are that Marsh teaches management of advertisement distribution service by a software producer or distributor. In fact, Marsh at column 3, lines 12-56 describes an advertisement distribution scheduler, an advertisement download scheduler, and the decorrelation of system advertisements from user e-mail. That is to say, a user's e-mail comes from other network users, while advertisements come from advertisers. However, the passage does not mention or suggest that the producer or the distributor of the user's software manage the distribution of advertisements, by a server or any other means. Accordingly, the applicants respectfully request citation of a reference or entry of an affidavit to support these contentions. See MPEP 2144.03.

Claims 23 and 24 are dependent from claim 1 which is patentably distinguishable from Marsh for reasons given above.

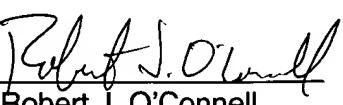
With respect to claims 25 and 38-40, it is admitted that Marsh does not teach "including the distributor identifier." In fact, Marsh also fails to teach software for use on a client device that includes the advertisement and audit data functions recited in claim 1, and further includes "a custom installer function that generates a distributor identifier". If Official Notice is intended to include such a function, the applicants submit that it is not and cannot be of such notorious character as to merit Official Notice. Accordingly, the applicants respectfully request citation of a reference or entry of an affidavit in this regard. See MPEP 2144.03.

Claims 126, 127, 136, 137, and 146 are dependent from claim 1 which is patentably distinguishable from Marsh for reasons given above.

Therefore, in view of the failure of the art of record in this application to teach or suggest the entire invention recited in claims 1-40, 111-113, 126, 127, 136, 137, and 146, it is submitted that these claims recite subject matter that is both novel and unobvious.

Respectfully submitted,

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